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## **I. STATUS OF CLAIMS**

Claims 1-48 are pending.

Claims 1-13 and 18-48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,625,101 to Hinks et al. (“Hinks” hereinafter). See *Examiner’s Office Action*, p. 2 (1 April 2009).

Claims 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hinks in view of U.S. Patent No. 5,481,102 to Hazelrigg et al. (“Hazelrigg” hereinafter). See *Examiner’s Office Action*, p. 4 (12 May 2008).

## **II. ISSUES TO BE REVIEWED**

The issues in this response relate to: whether the art of record establishes a *prima facie* case of the unpatentability of Applicant’s Claims 1-48. For reasons set forth elsewhere herein, Applicant respectfully asserts that the art of record does not establish a *prima facie* case of the unpatentability of any pending claim. Accordingly, Applicant respectfully requests that Examiner hold all pending Claims 1-48 allowable for at least the reasons described herein, and issue a Notice of Allowance on same.

## **III. ARGUMENT: ART OF RECORD DOES NOT ESTABLISH *PRIMA FACIE* CASE OF UNPATENTABILITY IN VIEW OF CITED ART OF RECORD**

Examiner has stated “Claims 1-13 and 18-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Hinks et al (US 4,625,101)”; and “Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinks et al in view of Hazelrigg et al (US 5,481,102).” See *Examiner’s Office Action*, pp. 2 and 4 (1 April 2009).

In response, Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability as set forth below, the art of record does not establish a *prima facie* case of the unpatentability of Applicant’s claims at issue. Specifically, Applicant respectfully shows below that the art of record does not recite the text of Applicant’s claims at issue, and hence fails to establish a *prima facie* case of unpatentability. Accordingly, Applicant respectfully requests that the Examiner withdraw his rejections and hold all claims to be allowable over the art of record.

## **A. MPEP Standards for Patentability<sup>1</sup>**

The MPEP states as follows: "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. . . . If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." MPEP § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)); *In Re Glaug* 283 F.3d 1335, 62 USPQ2d 1151 (Fed. Cir. 2002) ("During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent."). Accordingly, unless and until an examiner presents evidence establishing *prima facie* unpatentability, an applicant is entitled to a patent on all claims presented for examination.

### **1. MPEP Standards for Determining Anticipation**

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); MPEP § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")). Failure of an examiner to meet this burden entitles an applicant to a patent. *Id.* ("[i]f examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent").

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<sup>1</sup> Applicant is aware that Examiner is familiar with the MPEP standards. Applicant is merely setting forth the MPEP standards to serve as a framework for Applicant's arguments following and to ensure a complete written record is established. Should Examiner disagree with Applicant's characterization of the MPEP standards, Applicant respectfully requests correction.

The MPEP indicates that in order for an examiner to establish a *prima facie* case of anticipation of an applicant's claim, the examiner must first interpret the claim,<sup>2</sup> and thereafter show that the cited prior art discloses the same elements, in the same arrangement, as the elements of the claim which the examiner asserts is anticipated. More specifically, the MPEP states that "[a] claim is anticipated *only if each and every element as set forth in the claim is found*, either expressly or inherently described, in a single prior art reference. . . . The identical invention must be shown *in as complete detail* as is contained in the . . . claim. . . . The elements must be *arranged as required by the claim* . . . ." MPEP § 2131 (emphasis added). Consequently, under the guidelines of the MPEP set forth above, if there is *any* substantial difference between the prior art cited by an examiner and an applicant's claim which the examiner asserts is rendered anticipated by the prior art, the prior art does NOT establish a *prima facie* case of anticipation and, barring other rejections, the applicant is entitled to a patent on such claim.

## **2. MPEP Standards for Determining Obviousness**

"[T]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness."<sup>3</sup> MPEP § 2142. The MPEP indicates that in order for an examiner to establish a *prima facie* case that an invention, as defined by a claim at issue, is obvious, the examiner must (1) interpret the claim at issue; (2) define one or more prior art reference components relevant to the claim at issue; (3) ascertain the differences between the one or more prior art reference components and the elements of the claim at issue; and (4) adduce objective evidence which establishes, under a preponderance of the evidence standard, a teaching to modify the teachings of the prior

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<sup>2</sup> With respect to interpreting a claim at issue, the MPEP directs that, during examination -- as opposed to subsequent to issue -- such claim be interpreted as broadly as the claim terms would reasonably allow, in light of the specification, when read by one skilled in the art with which the claimed invention is most closely connected. MPEP § 2111.

<sup>3</sup> An invention, as embodied in the claims, is rendered obvious if an examiner concludes that although the claimed invention is not identically disclosed or described in a reference, the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. MPEP § 2141 (citing 35 U.S.C. § 103).

art reference components such that the prior art reference components can be used to construct a device substantially equivalent to the claim at issue. This last step generally encompasses two sub-steps: (1) adducement of objective evidence teaching how to modify the prior art components to achieve the individual elements of the claim at issue; and (2) adducement of objective evidence teaching how to combine the modified individual components such that the claim at issue, as a whole, is achieved. *MPEP* § 2141; *MPEP* § 2143. Each of these foregoing elements is further defined within the *MPEP*. *Id.*

This requirement has been explained recently by the Supreme Court in *KSR v. Teleflex*, 550 U.S. \_\_\_\_; 127 S. Ct. 1727 (2007) which noted that such a rejection requires "some articulated reasoning ... to support the legal conclusion of obviousness." As stated by the Court, obviousness can be established where "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, **this analysis should be made explicit.**" (*emphasis added*) See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.')."*KSR v. Teleflex*, 550 U.S. \_\_\_\_; 127 S. Ct. 1727 at 1741.

As further described by the Court "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR v. Teleflex*, 550 U.S. \_\_\_\_; 127 S. Ct. 1727 at 1741.



**a) Interpreting a Claim at Issue**

With respect to interpreting a claim at issue, the MPEP directs that, during examination – as opposed to subsequent to issue – such claim be interpreted as broadly as the claim terms would reasonably allow when read by one skilled in the art with which the claimed invention is most closely connected. In practice, this is achieved by giving each of the terms in the claim the "plain meaning" of the terms as such would be understood by those having ordinary skill in the art, and if portions of the claim have no "plain meaning" within the art, or are ambiguous as used in a claim, then the examiner is to consult the specification for clarification. *MPEP* § 2111.

**b) Definition of One or More Prior Art Reference Components Relevant to the Claim at Issue**

Once the claim at issue has been properly interpreted, the next step is the definition of one or more prior art reference components (*e.g.*, electrical, mechanical, or other components set forth in a prior art reference) relevant to the properly interpreted claim at issue. With respect to the definition of one or more prior art reference components relevant to the claim at issue, the MPEP defines three proper sources of such prior art reference components, with the further requirement that each such source must have been extant at the time of invention to be considered relevant. These three sources are as follows: patents as defined by 35 U.S.C. § 102, printed publications as defined by 35 U.S.C. § 102 and information (*e.g.*, scientific principles) deemed to be "well known in the art"<sup>4</sup> as defined under 35 U.S.C. § 102. *MPEP* § 2141; *MPEP* § 2144.

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<sup>4</sup> The fact that information deemed to be "well known in the art" can serve as a proper source of prior art reference components seems to open the door to subjectivity, but such is not the case. As a remedy to this potential problem, *MPEP* § 2144.03 states that if an examiner asserts that his position is derived from and/or is supported by a teaching or suggestion that is alleged to have been "well known in the art," and that if an applicant traverses such an assertion (that something was "well known within the art"), the examiner must cite a reference in support of his or her position. The same *MPEP* section also states that when a rejection is based on facts within the personal knowledge of an examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. *Id.* Thus, all sources of prior art reference components must be objectively verifiable.

**c) Ascertainment of Differences between Prior Art Reference Components and Claim at Issue; Teaching to Modify and/or Combine Prior Art Reference Components to Remedy Those Differences in Order to Achieve Recitations of Claim at Issue**

With one or more prior art components so defined and drawn from the proper prior art sources, the differences between the one or more prior art reference components and the elements of the claim at issue are to be ascertained. Thereafter, in order to establish a case of *prima facie* obviousness, an examiner must set forth a rationale, supported by objective evidence<sup>5</sup> sufficient to demonstrate under a preponderance of the evidence standard, that in the prior art extant at the time of invention there was a teaching to modify and/or combine the one or more prior art reference components to construct a device practicably equivalent to the claim at issue.

The preferable evidence relied upon is an express teaching to modify/combine within the properly defined objectively verifiable sources of prior art. In the absence of such express teaching, an examiner may attempt to establish a rationale to support a finding of such teaching reasoned from, or based upon, express teachings taken from the defined proper sources of such evidence (*i.e.*, properly defined objectively verifiable sources of prior art). *MPEP* § 2144; *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

The MPEP recognizes the pitfalls associated with the tendency to subconsciously use impermissible "hindsight" when an examiner attempts to establish such a rationale. The MPEP has set forth at least two rules to ensure against the likelihood of such impermissible use of hindsight. The first rule is that:

under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information,<sup>6</sup> the examiner must then make a determination

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<sup>5</sup> The proper sources of the objective evidence supporting the rationale are the defined proper sources of prior art reference components, discussed above, with the addition of factually similar legal precedent. *MPEP* § 2144.

<sup>6</sup> "Factual information" is information actually existing or occurring, as distinguished from mere supposition or opinion. *Black's Law Dictionary* 532 (5th ed. 1979).

whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of an Applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search, and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon an Applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

*MPEP* § 2142 (emphasis added). Thus, if the only objective evidence of such teaching to modify and/or combine prior art reference components is an applicant's disclosure, no evidence of such teaching exists.<sup>7</sup>

The second rule is that if an examiner attempts to rely on some advantage or expected beneficial result that would have been produced by a modification and/or combination of the prior art reference components as evidence to support a rationale to establish such teachings to modify and/or combine prior art reference components, the *MPEP* requires that such advantage or expected beneficial result be objectively verifiable teachings present in the acceptable sources of prior art (or drawn from a convincing line of reasoning based on objectively verifiable established scientific principles or teachings). *MPEP* § 2144. Thus, as a guide to avoid the use of impermissible hindsight, these rules from the *MPEP* make clear that absent some objective evidence, sufficient to persuade under a preponderance of the evidence standard, no teaching of such modification and/or combination exists.<sup>8</sup>

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<sup>7</sup> An applicant may argue that an examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *MPEP* § 2145(X)(A) (emphasis added).

<sup>8</sup> *In Re Sang Su Lee* 277 F.3d 1338 (Fed. Cir. 2002) ("When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.") See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors). "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art

## **B. Technical Material Cited by Examiner Does Not Recite Text of Claim 1**

### **1. Claim 1**

Claim 1 recites as follows: "An item comprising:

- a) an outer part including at least one outer material that is substantially opaque to visible light; and
- b) an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of
  - (1) a substantially empty cavity in the at least one outer material, or
  - (2) at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light."<sup>9</sup>

As shown following, the technical material cited by Examiner does not recite the text of Claim 1, and thus Applicant respectfully requests that Examiner allow Claim 1 for at least those reasons.

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references is an 'essential component of an obviousness holding') (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)). The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.")).

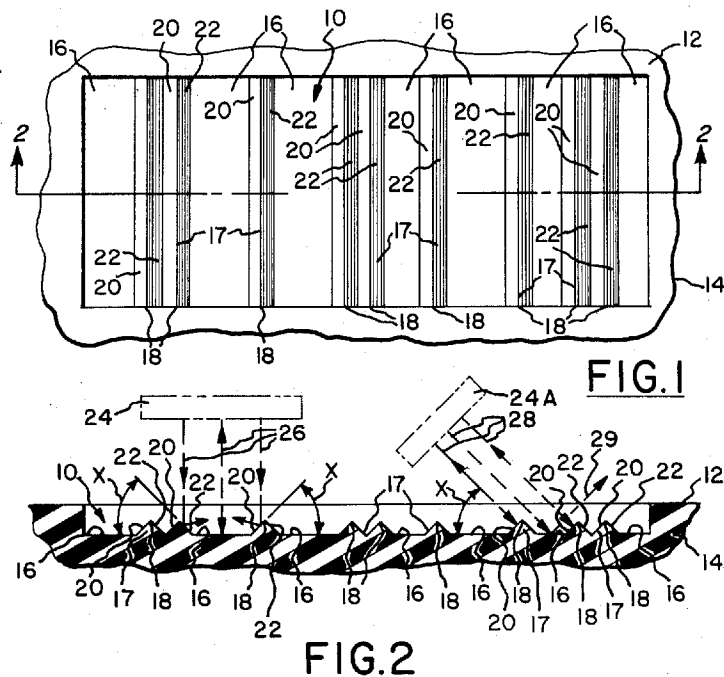
<sup>9</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

a) **The Examiner has Improperly Mapped the Recitations of Claim 1 to the Recitations of Hinks**

As set forth above, Claim 1 recites as follows: "An item comprising...b) an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being **embedded within** the at least one outer material..." (Emphasis added).

With respect to Claim 1, Examiner has stated "Hinks teaches regarding claim 1...an item...comprising: an outer part (tire 14) including at least one outer material that is substantially opaque to visible light; and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least three-dimensional configuration being embedded within the at least one outer material and including at least one of: a substantially empty cavity in the at least one outer material (col. 2, lines 55-68)..." See *Examiner's Office Action*, p. 2 (1 April 2009). Applicant respectfully disagrees and traverses the rejection.

Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner (e.g. col. 2, lines 55-68) and, as far as Applicant can discern, the Examiner-identified portions of Hinks do not recite the text of Applicant's Claim 1. Rather, the portion of Hinks cited by Examiner recites as follows:



Referring to FIGS. 1 and 2, a bar code configuration 10 embodying the invention is shown molded in a **surface** such as sidewall 12 of an article such as tire 14. The bar code configuration 10 includes even **surface** portions such as flats 16 separated by uneven **surface** portions such as rib portions 17. The bar code configuration 10 has generally parallel adjacent flats 16 and rib portions 17. Ribs 18 of rib portions 17 may have sawtooth cross sections and sloped faces 20 and 22 at an angle X to the plane of the flats 16 as shown in FIG. 2. The angle X may be from about 35 degrees to 55 degrees and in this embodiment is about 45 degrees. The ribs 18 also extend in a direction generally parallel to the direction of the flats 16 and rib portions 17.

*Hinks, col. 2, lines 55-68 (Emphasis added).*

As can be seen from the foregoing, the examiner-identified portions of Hinks (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of at least clause (b) as recited in Claim 1. For instance, clause (b) recites "an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being **embedded within** the at least one outer material." (Emphasis added). Nowhere in the examiner-identified portions of Hinks is there a recitation of this clause. Rather, the examiner-identified portions of Hinks merely recite "The bar code configuration 10 includes even **surface** portions such as flats 16 separated by uneven **surface** portions such as rib portions 17..."

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause (b) of Claim 1.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 1 in view of

Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 1. Applicant respectfully asks Examiner to hold Claim 1 allowable and to issue a Notice of Allowance of same.

**2. Claims 2-12 Patentable for at Least Reasons of Dependency from Claim 1**

Claims 2-12 depend either directly or indirectly from Claim 1. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 2-12 are patentable for at least the reasons why Claim 1 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Claims 2-12 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

**3. Claim 2 Independently Patentable**

Claim 2 recites as follows: "the at least one outer material is transmissive to RF radiation."

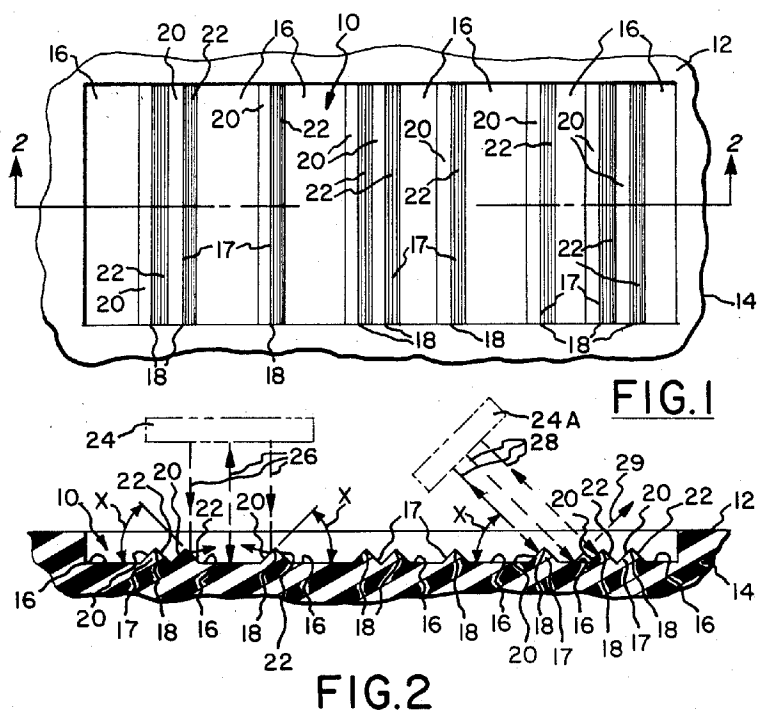
As shown following, the technical material cited by Examiner does not recite the text of Claim 2, and thus Applicant respectfully requests that Examiner allow Claim 2 for at least those reasons.

**a) The Examiner has Improperly Mapped the Recitations of Claim 2 to the Recitations of Hinks**

With respect to Claim 2, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one outer material is transmissive to RF radiation (light of scanner 24)." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner, and, as far as Applicant can discern, the Examiner-identified portions of

Hinks do not recite the text of Applicant's Claim 2. Rather, the portion of Hinks cited by Examiner recites as follows:



As can be seen from the foregoing, the portions of Hinks cited by the Examiner with respect of Claim 2 (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of Claim 2. Particularly, Hinks fails to recite “the at least one outer material is transmissive to RF radiation.”

**b) Portions of Hinks Expressly Teach Away from the Recitations of Claim 2**

Applicant respectfully submits that portions of Hinks not cited by the Examiner expressly teach away from the “the at least one outer material is transmissive to RF radiation” related text of Claim 2. For example, Hinks recites:

Light from the light source in the scanner 24 is received in a first direction 26 by the flats 16 and reflected in the first direction to the receiving sensor in the scanner.

*Hinks, col. 3, lines 7-9.*



It is well established that “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” (Emphasis added) *M.P.E.P. 2141.02*, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Applicant respectfully submits that the portion of Hinks cited above expressly teaches away from Claim 2 (e.g. “reflected” recitation of Hinks teaches away from the “transmissive” recitation of Claim 2).

### **c) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 2.

Applicant respectfully points out that the Applicant’s Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks’ express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant’s application, which is impermissible hindsight use. Thus, at present, Examiner’s assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 2 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 2. Applicant respectfully asks Examiner to hold Claim 2 allowable and to issue a Notice of Allowance of same.

### **4. Claim 3 Independently Patentable**

Claim 3 recites as follows: “the item is produced by rapid prototyping.” As shown following, the technical material cited by Examiner does not recite the text of Claim 3, and thus Applicant respectfully requests that Examiner allow Claim 3 for at least those reasons.

**a) The Examiner has Failed to Provide Support for Examiners Assertion that Hinks recites Claim 3**

With respect to Claim 3, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one outer material is produced by rapid prototyping." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "the item is produced by rapid prototyping"-related text of Claim 3.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 3, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 3.

**b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 3.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 3 in view of

Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 3. Applicant respectfully asks Examiner to hold Claim 3 allowable and to issue a Notice of Allowance of same.

## **5. Claim 6 Independently Patentable**

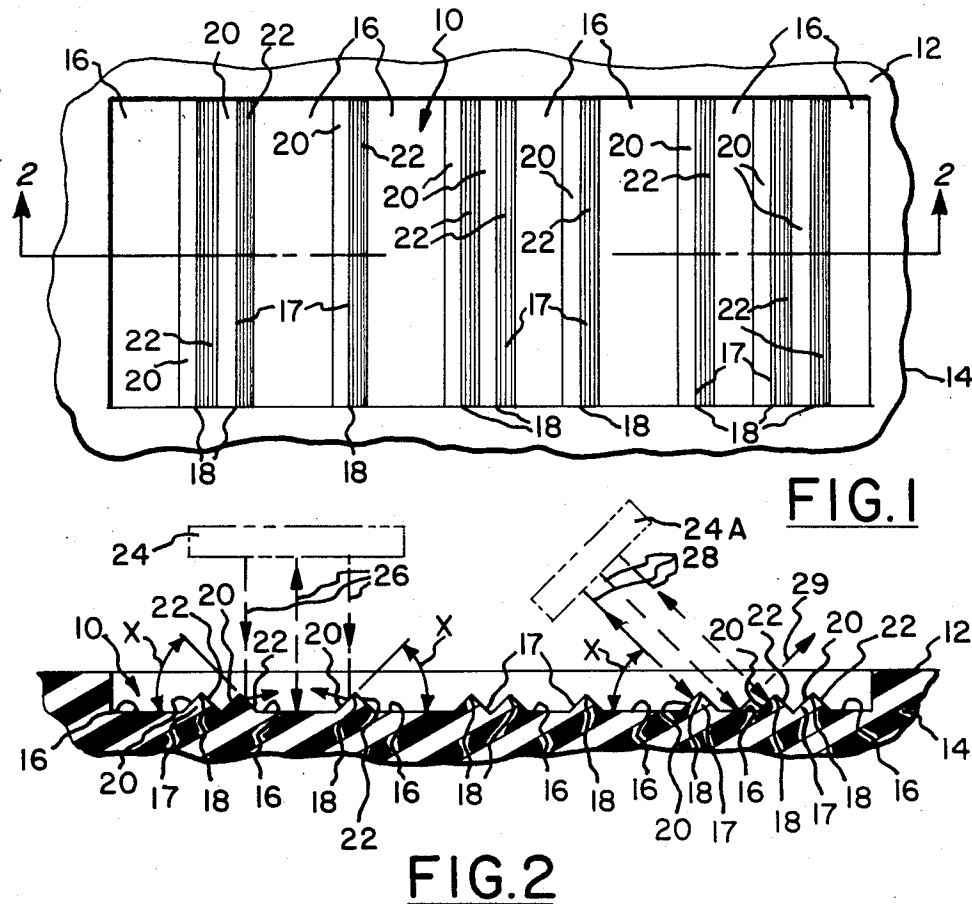
Claim 6 recites as follows: "the at least one three-dimensional configuration is completely enclosed by the at least one outer material."

As shown following, the technical material cited by Examiner does not recite the text of Claim 6, and thus Applicant respectfully requests that Examiner allow Claim 6 for at least those reasons.

### **a) The Examiner has Improperly Mapped the Recitations of Claim 6 to the Recitations of Hinks**

With respect to Claim 6, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one three-dimensional configuration is completely enclosed by the at least one outer material (see Figure 2)." *See Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner, and, as far as Applicant can discern, the Examiner-identified portions of Hinks do not recite the text of Applicant's Claim 6. Rather, the portion of Hinks cited by Examiner recites as follows:



As can be seen from the foregoing, the portions of Hinks cited by the Examiner with respect of Claim 6 (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of Claim 6. Particularly, Hinks fails to recite “the at least one three-dimensional configuration is completely enclosed by the at least one outer material.”

**b) Portions of Hinks Expressly Teach Away from the Recitations of Claim 6**

Applicant respectfully submits that portions of Hinks not cited by the Examiner expressly teach away from the “the at least one three-dimensional configuration is completely enclosed by the at least one outer material” related text of Claim 6. For example, Hinks recites:

Referring to FIGS. 1 and 2, a bar code configuration 10 embodying the invention is shown molded in a surface such as sidewall 12 of an article

such as tire 14. The bar code configuration 10 includes even **surface portions** such as flats 16 separated by uneven **surface portions** such as rib portions 17. The bar code configuration 10 has generally parallel adjacent flats 16 and rib portions 17. Ribs 18 of rib portions 17 may have sawtooth cross sections and sloped faces 20 and 22 at an angle X to the plane of the flats 16 as shown in FIG. 2. The angle X may be from about 35 degrees to 55 degrees and in this embodiment is about 45 degrees. The ribs 18 also extend in a direction generally parallel to the direction of the flats 16 and rib portions 17.

*Hinks, col. 2, lines 55-68 (Emphasis added).*

It is well established that “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” (Emphasis added) *M.P.E.P. 2141.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Applicant respectfully submits that the portion of Hinks cited above expressly teaches away from Claim 6 (e.g. “surface portions” recitations of Hinks teaches away from the “completely enclosed” recitation of Claim 6).

### **c) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 6.

Applicant respectfully points out that the Applicant’s Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks’ express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant’s application, which is impermissible hindsight use. Thus, at present, Examiner’s assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 6 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 6. Applicant

respectfully asks Examiner to hold Claim 6 allowable and to issue a Notice of Allowance of same.

## **6. Claim 7 Independently Patentable**

Claim 7 recites as follows: "the at least one three-dimensional configuration is directly accessible by physically separating the at least one outer material into at least two parts." As shown following, the technical material cited by Examiner does not recite the text of Claim 7, and thus Applicant respectfully requests that Examiner allow Claim 7 for at least those reasons.

### **a) The Examiner has Failed to Provide Support for Examiners Assertion that Hinks recites Claim 7**

With respect to Claim 7, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light..." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "the at least one three-dimensional configuration is directly accessible by physically separating the at least one outer material into at least two parts"-related text of Claim 7.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 7, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 7.

**b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching claim 7.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 7 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 7. Applicant respectfully asks Examiner to hold Claim 7 allowable and to issue a Notice of Allowance of same.

**7. Claim 8 Independently Patentable**

Claim 8 recites as follows: "the at least one three-dimensional configuration is directly accessible only by disassembling the item."

As shown following, the technical material cited by Examiner does not recite the text of Claim 8, and thus Applicant respectfully requests that Examiner allow Claim 8 for at least those reasons.

**a) The Examiner has Improperly Mapped the Recitations of Claim 8 to the Recitations of Hinks**

With respect to Claim 8, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one three-dimensional configuration is directly accessible only by disassembling the item (col. 3, lines 56-63)." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner, and, as far as Applicant can discern, the Examiner-identified portions of Hinks do not recite the text of Applicant's Claim 8. Rather, the portion of Hinks cited by Examiner recites as follows:

In order to mold the bar code configuration 10 in the sidewall 12 of the tire 14, an insert 50 is fastened to an inner mold face 52 of a mold 54 which may be a two-piece mold as shown in FIG. 7. The mold 54 has a mold cavity 56 in which the uncured tire 14 is placed and the mold closed. A curing bladder 58 may be expanded into contact with the inner surface of the tire 14 during the curing process.

*Hinks, col. 3, lines 56-63 (Emphasis added).*

As can be seen from the foregoing, the portions of Hinks cited by the Examiner with respect of Claim 8 (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of Claim 8. Particularly, Hinks fails to recite “the at least one **three-dimensional configuration** is directly accessible only by disassembling the item.” Rather, the portion of Hinks cited by the Examiner merely recites: “an insert 50 is fastened to an inner mold face 52 of a mold 54 which may be a two-piece mold as shown in FIG. 7.”

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 8.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 8 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.



Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 8. Applicant respectfully asks Examiner to hold Claim 8 allowable and to issue a Notice of Allowance of same.

## **8. Claim 9 Independently Patentable**

Claim 9 recites as follows: "the item is produced by rapid prototyping." As shown following, the technical material cited by Examiner does not recite the text of Claim 9, and thus Applicant respectfully requests that Examiner allow Claim 9 for at least those reasons.

### **a) The Examiner has Failed to Provide Support for Examiner's Assertion that Hinks recites Claim 9**

With respect to Claim 9, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one identifying material emits identifying electromagnetic radiatoin [sic] when irradiated with specific electromagnetic radiation..." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "the at least one identifying material emits identifying electromagnetic radiation when irradiated with specified electromagnetic radiation"-related text of Claim 9.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 9, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 9.

**b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching claim Claim 9. Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 9 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 9. Applicant respectfully asks Examiner to hold Claim 9 allowable and to issue a Notice of Allowance of same.

**9. Claim 10 Independently Patentable**

Claim 10 recites as follows: "the identifying material comprises a re-radiating antenna." As shown following, the technical material cited by Examiner does not recite the text of Claim 10, and thus Applicant respectfully requests that Examiner allow Claim 10 for at least those reasons.

**a) The Examiner has Failed to Provide Support for Examiners Assertion that Hinks recites Claim 10**

With respect to Claim 10, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one identifying material emits identifying electromagnetic

radiation [sic] when irradiated with specific electromagnetic radiation..." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "the identifying material comprises a re-radiating antenna"-related text of Claim 10.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 10, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 10.

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching claim Claim 10.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 10 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 10. Applicant

respectfully asks Examiner to hold Claim 10 allowable and to issue a Notice of Allowance of same.

#### **10. Claim 11 Independently Patentable**

Claim 11 recites as follows: "the identifying material comprises a security tag." As shown following, the technical material cited by Examiner does not recite the text of Claim 11, and thus Applicant respectfully requests that Examiner allow Claim 11 for at least those reasons.

##### **a) The Examiner has Failed to Provide Support for Examiner's Assertion that Hinks recites Claim 11**

With respect to Claim 11, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one identifying material emits identifying electromagnetic radiation [sic] when irradiated with specific electromagnetic radiation..." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "the identifying material comprises a security tag"-related text of Claim 11.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 11, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 11.

**b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching claim 11.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 11 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 11. Applicant respectfully asks Examiner to hold Claim 11 allowable and to issue a Notice of Allowance of same.

**11. Claim 12 Independently Patentable**

Claim 12 recites as follows: "the identifying material comprises a radio-frequency identification device." As shown following, the technical material cited by Examiner does not recite the text of Claim 12, and thus Applicant respectfully requests that Examiner allow Claim 12 for at least those reasons.

**a) The Examiner has Failed to Provide Support for Examiners Assertion that Hinks recites Claim 12**

With respect to Claim 12, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one identifying material emits identifying electromagnetic radiatoin [sic] when irradiated with specific electromagnetic radiation..." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "the identifying material comprises a radio-frequency identification device"-related text of Claim 12.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks that the Examiner views as reciting Claim 12, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 12.

#### **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 12.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 12 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 12. Applicant respectfully asks Examiner to hold Claim 12 allowable and to issue a Notice of Allowance of same.

**C. Technical Material Cited by Examiner Does Not Recite Text of Claim 13**

**1. Claim 13**

Claim 13 recites as follows: " A method of identifying an item comprising:

- a) detecting an at least one three-dimensional configuration with a penetrating imaging tool, the detecting an at least one three-dimensional configuration with a penetrating imaging tool resulting in an output from the penetrating imaging tool; and
- b) reading identifying information by interpreting the output." <sup>10</sup>

As shown following, the technical material cited by Examiner does not recite the text of Claim 13, and thus Applicant respectfully requests that Examiner allow Claim 13 for at least those reasons.

**a) The Examiner has Improperly Mapped the Recitations of Claim 13 to the Recitations of Hinks**

As set forth above, Claim 13 recites as follows: "A method of identifying an item comprising: a) an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material..." (Emphasis added).

With respect to Claim 13, Examiner has stated "Hinks teaches regarding Claim 13...a method of identifying an item comprising: detecting at least one three-dimensional configuration with a penetrating imaging tool...(col. 3, lines 1-18)" See *Examiner's Office Action*, p. 3 (1 April 2009). Applicant respectfully disagrees and traverses the rejection.

Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner (e.g. col. 3, lines 1-18) and, as far as Applicant can discern, the Examiner-identified portions of Hinks do not recite the text of Applicant's Claim 13. Rather, the portion of Hinks cited by Examiner recites as follows:

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<sup>10</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

In the system described for scanning a bar code to provide information about the tire 14 on which the bar code configuration 10 is molded, a scanner 24, shown schematically in dashed lines, including a light source and the receiving sensor may be positioned over the bar code configuration as shown at the left side of FIG. 2. Light from the light source in the scanner 24 is received in a first direction 26 by the flats 16 and **reflected** in the first direction to the receiving sensor in the scanner. The light received from the light source in the scanner 24 in the first direction 26 by the sloped faces 20 and 22 of the ribs 18 is **reflected** in other directions different from the first direction to define the bars of the bar code. As shown in FIG. 2, the width of the rib portions 17 and the different spacing of the rib portions is conveyed to the scanner 24 during relative circumferential movement of the scanner relative to the ribs 18 which extend substantially radially of the tire 14.

*Hinks, col. 2, lines 55-68 (Emphasis added).*

As can be seen from the foregoing, the examiner-identified portions of Hinks (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of at least clause (a) as recited in Claim 13. For instance, clause (a) recites "an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one **three-dimensional configuration being** embedded within the at least one outer material." (Emphasis added).

Nowhere in the examiner-identified portions of Hinks is there a recitation of this clause (e.g. a "penetrating imaging tool"). Rather, the examiner-identified portions of Hinks merely recite: "Light from the light source in the scanner 24 is received in a first direction 26 by the flats 16 and **reflected** in the first direction to the receiving sensor in the scanner. The light received from the light source in the scanner 24 in the first direction 26 by the sloped faces 20 and 22 of the ribs 18 is **reflected** in other directions different from the first direction to define the bars of the bar code..."

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause (a) of Claim 13.



Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 13 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 13. Applicant respectfully asks Examiner to hold Claim 13 allowable and to issue a Notice of Allowance of same.

## **2. Claims 14-21 Patentable for at Least Reasons of Dependency from Claim 13**

Claims 14-21 depend either directly or indirectly from Claim 13. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 14-21 are patentable for at least the reasons why Claim 13 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Claims 14-21 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

## **3. Claim 18 Independently Patentable**

Claim 18 recites as follows: "reading identifying information from at least one identifying material emitting identifying electromagnetic radiation when irradiated with specified electromagnetic radiation." As shown following, the technical material cited by Examiner does not recite the text of Claim 18, and thus Applicant respectfully requests that Examiner allow Claim 18 for at least those reasons.

**a) The Examiner has Failed to Provide Support for  
Examiners Assertion that Hinks recites Claim 18**

With respect to Claim 18, Examiner has stated "Hinks teaches...a method of identifying an item...wherein the reading identifying information by interpreting the output includes: reading identifying information from at least one identifying material emitting identifying electromagnetic radioation [sic] when irradiated with specific electromagnetic radiation..." See *Examiner's Office Action*, p. 3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "reading identifying information from at least one identifying material emitting identifying electromagnetic radiation when irradiated with specified electromagnetic radiation"-related text of Claim 18.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 18, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 18.

**b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 18.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be

relying on personal knowledge in rejecting Claim 18 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 18. Applicant respectfully asks Examiner to hold Claim 18 allowable and to issue a Notice of Allowance of same.

#### **4. Claim 19 Independently Patentable**

Claim 19 recites as follows: "reading identifying information from a re-radiating antenna." As shown following, the technical material cited by Examiner does not recite the text of Claim 19, and thus Applicant respectfully requests that Examiner allow Claim 19 for at least those reasons.

##### **a) The Examiner has Failed to Provide Support for Examiners Assertion that Hinks recites Claim 19**

With respect to Claim 19, Examiner has stated "Hinks teaches...a method of identifying an item...wherein the reading identifying information by interpreting the output includes...reading identifying information from a re-radiating antenna..." See *Examiner's Office Action*, p. 3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "reading identifying information from a re-radiating antenna"-related text of Claim 19.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 19, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 19.

**b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 19. Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable.

Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 19 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 19. Applicant respectfully asks Examiner to hold Claim 19 allowable and to issue a Notice of Allowance of same.

**5. Claim 20 Independently Patentable**

Claim 20 recites as follows: "reading identifying information from a security tag." As shown following, the technical material cited by Examiner does not recite the text of Claim 20, and thus Applicant respectfully requests that Examiner allow Claim 20 for at least those reasons.

**a) The Examiner has Failed to Provide Support for Examiners Assertion that Hinks recites Claim 20**

With respect to Claim 20, Examiner has stated "Hinks teaches...a method of identifying an item...wherein the reading identifying information by interpreting the

output includes...reading identifying information from a security tag..." See *Examiner's Office Action*, p. 3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "reading identifying information from a security tag"-related text of Claim 20.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 20, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 20.

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 20. Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable.

Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 20 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 20. Applicant

respectfully asks Examiner to hold Claim 20 allowable and to issue a Notice of Allowance of same.

## **6. Claim 21 Independently Patentable**

Claim 21 recites as follows: "reading identifying information from a radio-frequency identification device." As shown following, the technical material cited by Examiner does not recite the text of Claim 21, and thus Applicant respectfully requests that Examiner allow Claim 21 for at least those reasons.

### **a) The Examiner has Failed to Provide Support for Examiners Assertion that Hinks recites Claim 21**

With respect to Claim 21, Examiner has stated "Hinks teaches...a method of identifying an item...wherein the reading identifying information by interpreting the output includes...reading identifying information from a radio frequency identification device." See *Examiner's Office Action*, p. 3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "reading identifying information from a radio-frequency identification device"-related text of Claim 21.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 21, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 21.

### **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 21.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable.

Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 21 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 21. Applicant respectfully asks Examiner to hold Claim 21 allowable and to issue a Notice of Allowance of same.

**D. Technical Material Cited by Examiner Does Not Recite Text of Claim 22**

**1. Claim 22**

Claim 22 recites as follows: "A method of making an item, the method comprising:

- a) forming at least one portion of the item from at least one structural material; and
- b) integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration corresponding to the identifying information, the at least one three-dimensional configuration including at least one of
  - (1) a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or

- (2) an identifying material substantially shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light." <sup>11</sup>

As shown following, the technical material cited by Examiner does not recite the text of Claim 22, and thus Applicant respectfully requests that Examiner allow Claim 22 for at least those reasons.

**a) The Examiner has Improperly Mapped the Recitations of Claim 22 to the Recitations of Hinks**

As set forth above, Claim 22 recites as follows: " A method of making an item, the method comprising...b)...enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration corresponding to the identifying information..." (Emphasis added).

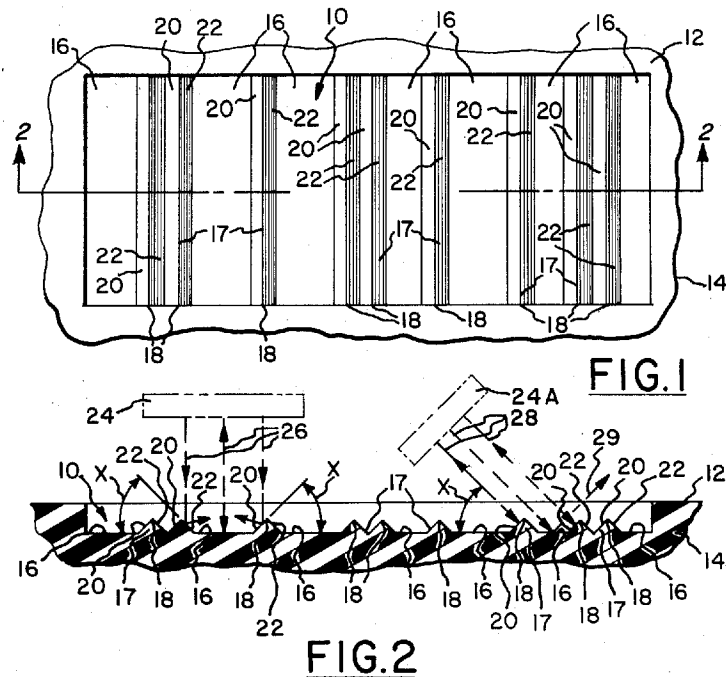
With respect to Claim 22, Examiner has stated "Hinks teaches regarding Claim 22...an item...comprising: an outer part (tire 14) including at least one outer material that is substantially opaque to visible light; and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least three-dimensional configuration being embedded within the at least one outer material and including at least one of: a substantially empty cavity in the at least one outer material (col. 2, lines 55-68)..." See *Examiner's Office Action*, p. 2 (1 April 2009). Applicant respectfully disagrees and traverses the rejection.

Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner (e.g. col. 2, lines 55-68) and, as far as Applicant can discern, the Examiner-identified portions of Hinks do not recite the text of Applicant's Claim 22. Rather, the portion of Hinks cited by Examiner recites as follows:

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<sup>11</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.





Referring to FIGS. 1 and 2, a bar code configuration 10 embodying the invention is shown molded in a surface such as sidewall 12 of an article such as tire 14. The bar code configuration 10 includes even surface portions such as flats 16 separated by uneven surface portions such as rib portions 17. The bar code configuration 10 has generally parallel adjacent flats 16 and rib portions 17. Ribs 18 of rib portions 17 may have sawtooth cross sections and sloped faces 20 and 22 at an angle X to the plane of the flats 16 as shown in FIG. 2. The angle X may be from about 35 degrees to 55 degrees and in this embodiment is about 45 degrees. The ribs 18 also extend in a direction generally parallel to the direction of the flats 16 and rib portions 17.

*Hinks, col. 2, lines 55-68 (Emphasis added).*

As can be seen from the foregoing, the examiner-identified portions of Hinks (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of at least clause (b) as recited in Claim 22. For instance, clause (b) recites "enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration corresponding to the identifying information." (Emphasis added). Nowhere in the examiner-identified portions of Hinks is there a recitation of this clause. Rather, the examiner-identified portions of Hinks merely recite

"The bar code configuration 10 includes even **surface** portions such as flats 16 separated by uneven **surface** portions such as rib portions 17..."

### **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause (b) of Claim 22.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 22 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 22. Applicant respectfully asks Examiner to hold Claim 22 allowable and to issue a Notice of Allowance of same.

### **2. Claims 23-33 Patentable for at Least Reasons of Dependency from Claim 22**

Claims 23-33 depend either directly or indirectly from Claim 22. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 23-33 are patentable for at least the reasons why Claim 22 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Claims 23-33 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

### **3. Claim 32 Independently Patentable**

Claim 32 recites as follows: "making the identifying information directly accessible by physically separating the at least one portion into at least two parts." As

shown following, the technical material cited by Examiner does not recite the text of Claim 32, and thus Applicant respectfully requests that Examiner allow Claim 32 for at least those reasons.

**a) The Examiner has Failed to Provide Support for  
Examiners Assertion that Hinks recites Claim 32**

With respect to Claim 32, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light..." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "making the identifying information directly accessible by physically separating the at least one portion into at least two parts"-related text of Claim 32.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 32, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 32.

**b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 32. Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is

impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 32 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 32. Applicant respectfully asks Examiner to hold Claim 32 allowable and to issue a Notice of Allowance of same.

#### **4. Claim 33 Independently Patentable**

Claim 33 recites as follows: "making the identifying information directly accessible only by disassembling the item."

As shown following, the technical material cited by Examiner does not recite the text of Claim 33, and thus Applicant respectfully requests that Examiner allow Claim 33 for at least those reasons.

##### **a) The Examiner has Improperly Mapped the Recitations of Claim 33 to the Recitations of Hinks**

With respect to Claim 33, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one three-dimensional configuration is directly accessible only by disassembling the item (col. 3, lines 56-63)." *See Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner, and, as far as Applicant can discern, the Examiner-identified portions of Hinks do not recite the text of Applicant's Claim 33. Rather, the portion of Hinks cited by Examiner recites as follows:

In order to mold the bar code configuration 10 in the sidewall 12 of the tire 14, an insert 50 is fastened to an inner mold face 52 of a mold 54 which may be a two-piece mold as shown in FIG. 7. The mold 54 has a mold cavity 56 in which the uncured tire 14 is placed and the mold closed. A

curing bladder 58 may be expanded into contact with the inner surface of the tire 14 during the curing process.

*Hinks, col. 3, lines 56-63 (Emphasis added).*

As can be seen from the foregoing, the portions of Hinks cited by the Examiner with respect of Claim 33 (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of Claim 33. Particularly, Hinks fails to recite “making the identifying information directly accessible only by disassembling the item.” Rather, the portion of Hinks cited by the Examiner merely recites: “an insert 50 is fastened to an inner mold face 52 of a mold 54 which may be a two-piece mold as shown in FIG. 7.”

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 33.

Applicant respectfully points out that the Applicant’s Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks’ express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant’s application, which is impermissible hindsight use. Thus, at present, Examiner’s assertions regarding Hinks are untenable.

Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 33 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 33. Applicant respectfully asks Examiner to hold Claim 33 allowable and to issue a Notice of Allowance of same.

**E. Technical Material Cited by Examiner Does Not Recite Text of Claim 34**

**1. Claim 34**

Claim 34 recites as follows: " A method of making an item, the method comprising:

- a) forming at least one portion of the item from at least one structural material; and
- b) integrally with the forming the at least one portion, enclosing within the at least structural material a void substantially shaped as at least one three dimensional configuration corresponding to identifying information that identifies the item, the void being defined by the at least one structural material"<sup>12</sup>

As shown following, the technical material cited by Examiner does not recite the text of Claim 34, and thus Applicant respectfully requests that Examiner allow Claim 34 for at least those reasons.

**a) The Examiner has Improperly Mapped the Recitations of Claim 34 to the Recitations of Hinks**

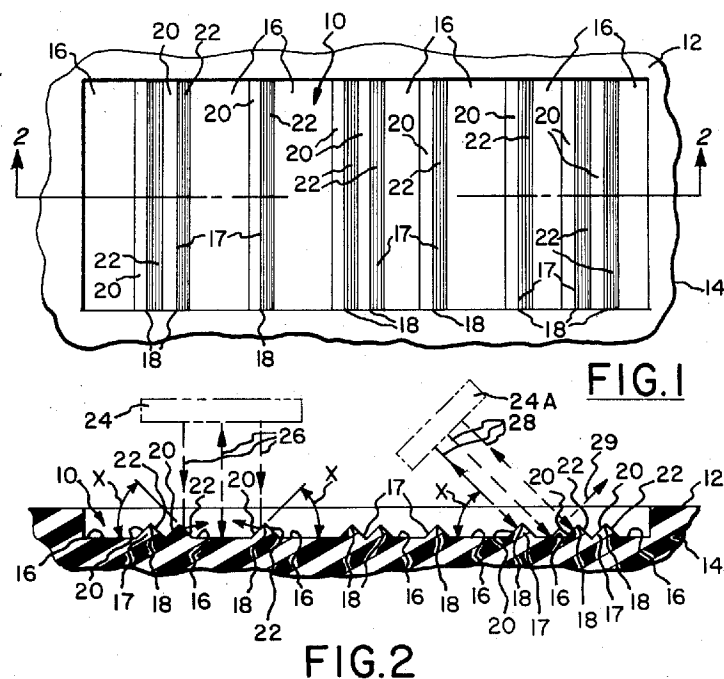
As set forth above, Claim 34 recites as follows: " A method of making an item, the method comprising...b)...enclosing **within** the at least structural material **a void substantially shaped as at least one three dimensional configuration** corresponding to identifying information that identifies the item..." (Emphasis added).

With respect to Claim 34, Examiner has stated "Hinks teaches regarding Claim 34...an item...comprising: an outer part (tire 14) including at least one outer material that is substantially opaque to visible light; and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least three-dimensional configuration being embedded within the at least one outer material and including at least one of: a substantially empty cavity in the at least one outer material (col. 2, lines 55-68)..." See *Examiner's Office Action*, p. 2 (1 April 2009). Applicant respectfully disagrees and traverses the rejection.

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<sup>12</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner (e.g. col. 2, lines 55-68) and, as far as Applicant can discern, the Examiner-identified portions of Hinks do not recite the text of Applicant's Claim 34. Rather, the portion of Hinks cited by Examiner recites as follows:



Referring to FIGS. 1 and 2, a bar code configuration 10 embodying the invention is shown molded in a **surface** such as sidewall 12 of an article such as tire 14. The bar code configuration 10 includes even **surface** portions such as flats 16 separated by uneven **surface** portions such as rib portions 17. The bar code configuration 10 has generally parallel adjacent flats 16 and rib portions 17. Ribs 18 of rib portions 17 may have sawtooth cross sections and sloped faces 20 and 22 at an angle X to the plane of the flats 16 as shown in FIG. 2. The angle X may be from about 35 degrees to 55 degrees and in this embodiment is about 45 degrees. The ribs 18 also extend in a direction generally parallel to the direction of the flats 16 and rib portions 17.

*Hinks, col. 2, lines 55-68 (Emphasis added).*

As can be seen from the foregoing, the examiner-identified portions of Hinks (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of at least clause (b) as recited in Claim 34. For instance, clause (b) recites "enclosing **within** the at least structural material **a void**

substantially shaped as at least one three dimensional configuration corresponding to identifying information that identifies the item." (Emphasis added). Nowhere in the examiner-identified portions of Hinks is there a recitation of this clause. Rather, the examiner-identified portions of Hinks merely recite "The bar code configuration 10 includes even **surface** portions such as flats 16 separated by uneven **surface** portions such as rib portions 17..."

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause (b) of Claim 34.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 34 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 34. Applicant respectfully asks Examiner to hold Claim 34 allowable and to issue a Notice of Allowance of same.

## **2. Claims 35-36 Patentable for at Least Reasons of Dependency from Claim 34**

Claims 35-36 depend either directly or indirectly from Claim 34. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 35-36 are patentable for at least the reasons why Claim 34 is patentable. Accordingly,



Applicant respectfully requests that Examiner hold Claims 35-36 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

### **3. Claim 35 Independently Patentable**

Claim 35 recites as follows: "enclosing within the void at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration." As shown following, the technical material cited by Examiner does not recite the text of Claim 35, and thus Applicant respectfully requests that Examiner allow Claim 35 for at least those reasons.

#### **a) The Examiner has Failed to Provide Support for Examiners Assertion that Hinks recites Claim 35**

With respect to Claim 35, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light..." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "enclosing within the void at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration"-related text of Claim 35.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 35, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 35.

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching claim 35.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 35 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 35. Applicant respectfully asks Examiner to hold Claim 35 allowable and to issue a Notice of Allowance of same.

## **F. Technical Material Cited by Examiner Does Not Recite Text of Claim 37**

### **1. Claim 37**

Claim 37 recites as follows: "A method of forming a computer-readable representation of an item, the method comprising:

- forming an outer surface computer-readable representation part including a representation of the outer surface of the item;
- forming an identifying surface computer-readable representation part of at least one closed three-dimensional identifying surface, the at least one identifying surface corresponding to identifying information that identifies the item, and the at least one identifying surface being contained within the outer surface; and

associating the outer surface computer-readable representation part and the identifying surface computer-readable representation part." <sup>13</sup>

As shown following, the technical material cited by Examiner does not recite the text of Claim 37, and thus Applicant respectfully requests that Examiner allow Claim 37 for at least those reasons.

**a) The Examiner has Improperly Mapped the Recitations of Claim 37 to the Recitations of Hinks**

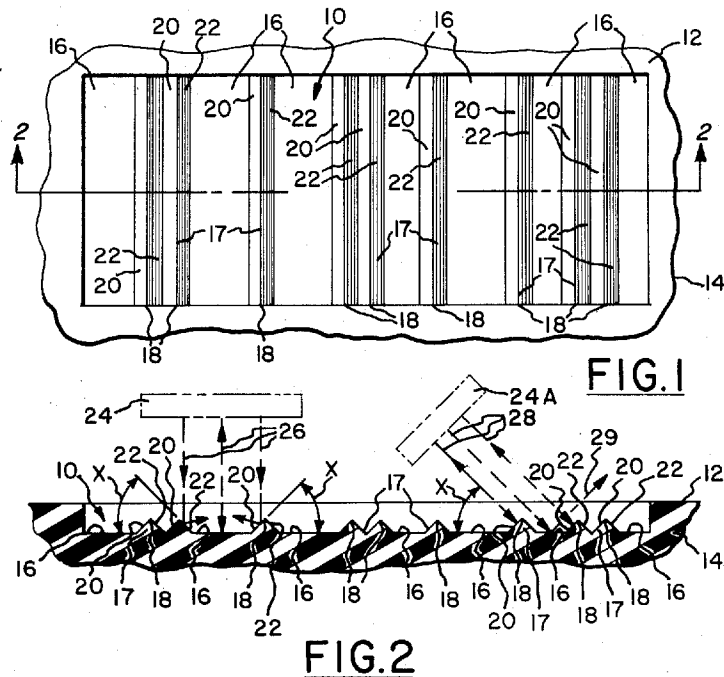
As set forth above, Claim 37 recites as follows: " A method of making an item, the method comprising...b)...the at least one identifying surface being contained within the outer surface..." (Emphasis added).

With respect to Claim 37, Examiner has stated "Hinks teaches regarding Claim 37...an item...comprising: an outer part (tire 14) including at least one outer material that is substantially opaque to visible light; and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least three-dimensional configuration being embedded within the at least one outer material and including at least one of: a substantially empty cavity in the at least one outer material (col. 2, lines 55-68)..." See *Examiner's Office Action*, p. 2 (1 April 2009). Applicant respectfully disagrees and traverses the rejection.

Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner (e.g. col. 2, lines 55-68) and, as far as Applicant can discern, the Examiner-identified portions of Hinks do not recite the text of Applicant's Claim 37. Rather, the portion of Hinks cited by Examiner recites as follows:

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<sup>13</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.



Referring to FIGS. 1 and 2, a bar code configuration 10 embodying the invention is shown molded in a surface such as sidewall 12 of an article such as tire 14. The bar code configuration 10 includes even surface portions such as flats 16 separated by uneven surface portions such as rib portions 17. The bar code configuration 10 has generally parallel adjacent flats 16 and rib portions 17. Ribs 18 of rib portions 17 may have sawtooth cross sections and sloped faces 20 and 22 at an angle X to the plane of the flats 16 as shown in FIG. 2. The angle X may be from about 35 degrees to 55 degrees and in this embodiment is about 45 degrees. The ribs 18 also extend in a direction generally parallel to the direction of the flats 16 and rib portions 17.

*Hinks, col. 2, lines 55-68 (Emphasis added).*

As can be seen from the foregoing, the examiner-identified portions of Hinks (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of at least clause (b) as recited in Claim 37. For instance, clause (b) recites "the at least one identifying surface being contained within the outer surface." (Emphasis added). Nowhere in the examiner-identified portions of Hinks is there a recitation of this clause. Rather, the examiner-identified portions of Hinks merely recite "The bar code configuration 10 includes even **surface** portions such as flats 16 separated by uneven **surface** portions such as rib portions 17..."

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause (b) of Claim 37.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 37 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 37. Applicant respectfully asks Examiner to hold Claim 37 allowable and to issue a Notice of Allowance of same.

## **2. Claims 38-42 Patentable for at Least Reasons of Dependency from Claim 34**

Claims 38-42 depend either directly or indirectly from Claim 37. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 38-42 are patentable for at least the reasons why Claim 37 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Claims 38-42 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

## **3. Claim 38 Independently Patentable**

Claim 38 recites as follows: "the item is produced by rapid prototyping." As shown following, the technical material cited by Examiner does not recite the text of Claim 38, and thus Applicant respectfully requests that Examiner allow Claim 38 for at least those reasons.

**a) The Examiner has Failed to Provide Support for  
Examiners Assertion that Hinks recites Claim 38**

With respect to Claim 38, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one outer material is produced by rapid prototyping." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting the "the item is produced by rapid prototyping"-related text of Claim 38.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....")).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 38, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 38.

**b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 38.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 38 in view of

Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 38. Applicant respectfully asks Examiner to hold Claim 38 allowable and to issue a Notice of Allowance of same.

**G. Technical Material Cited by Examiner Does Not Recite Text of Claim 43**

**1. Claim 43**

Claim 43 recites as follows: "A method of manufacturing an item, the method comprising:

forming a computer-readable representation of the item, the computer-readable representation including a representation of at least one three-dimensional configuration, the at least one three-dimensional configuration corresponding to identifying information that identifies the item; and  
producing the item using the computer-readable representation of the item, the item including

- (1) at least one structural material, and
- (2) the at least one three-dimensional configuration, the at least one three-dimensional configuration including at least one of (a) a void within the at least one structural material, or (b) at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material, wherein the at least one structural material enclosing the at least one identifying material is substantially opaque to visible light."<sup>14</sup>

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<sup>14</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

As shown following, the technical material cited by Examiner does not recite the text of Claim 43, and thus Applicant respectfully requests that Examiner allow Claim 43 for at least those reasons.

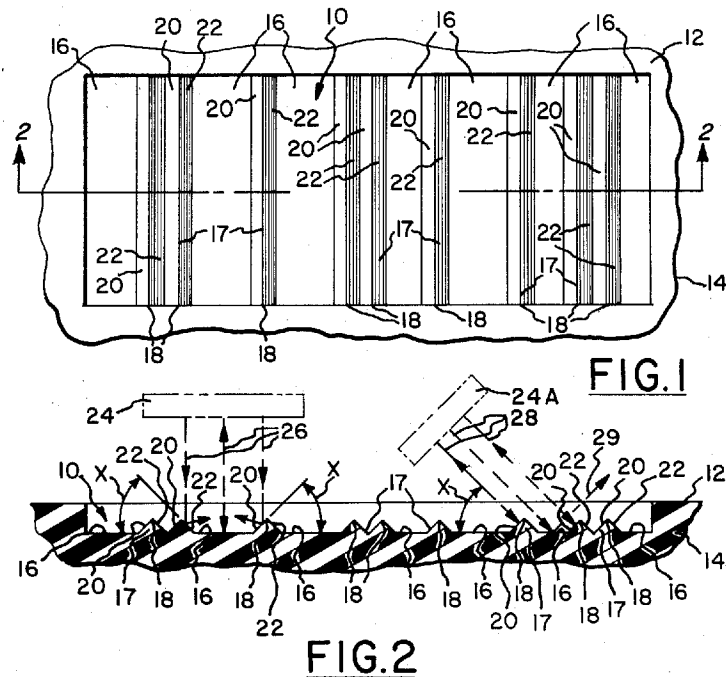
**a) The Examiner has Improperly Mapped the Recitations of Claim 43 to the Recitations of Hinks**

As set forth above, Claim 43 recites as follows: " A method of making an item, the method comprising...the at least one three-dimensional configuration, the at least one three-dimensional configuration including at least one of (a) a void **within** the at least one structural material, or (b) at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration and **enclosed within** the at least one structural material, wherein the at least one structural material enclosing the at least one identifying material is substantially opaque to visible light..." (Emphasis added).

With respect to Claim 43, Examiner has stated "Hinks teaches regarding Claim 43...an item...comprising: an outer part (tire 14) including at least one outer material that is substantially opaque to visible light; and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least three-dimensional configuration being embedded within the at least one outer material and including at least one of: a substantially empty cavity in the at least one outer material (col. 2, lines 55-68)..." See *Examiner's Office Action*, p. 2 (1 April 2009). Applicant respectfully disagrees and traverses the rejection.

Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner (e.g. col. 2, lines 55-68) and, as far as Applicant can discern, the Examiner-identified portions of Hinks do not recite the text of Applicant's Claim 43. Rather, the portion of Hinks cited by Examiner recites as follows:





Referring to FIGS. 1 and 2, a bar code configuration 10 embodying the invention is shown molded in a surface such as sidewall 12 of an article such as tire 14. The bar code configuration 10 includes even surface portions such as flats 16 separated by uneven surface portions such as rib portions 17. The bar code configuration 10 has generally parallel adjacent flats 16 and rib portions 17. Ribs 18 of rib portions 17 may have sawtooth cross sections and sloped faces 20 and 22 at an angle X to the plane of the flats 16 as shown in FIG. 2. The angle X may be from about 35 degrees to 55 degrees and in this embodiment is about 45 degrees. The ribs 18 also extend in a direction generally parallel to the direction of the flats 16 and rib portions 17.

*Hinks, col. 2, lines 55-68 (Emphasis added).*

As can be seen from the foregoing, the examiner-identified portions of Hinks (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of Claim 43. For instance, Claim 43 recites "the at least one three-dimensional configuration, the at least one three-dimensional configuration including at least one of (a) a void within the at least one structural material, or (b) at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material, wherein the at least one structural material enclosing the at least one identifying material is substantially opaque to visible light." (Emphasis added).

Nowhere in the examiner-identified portions of Hinks is there a recitation of this clause. Rather, the examiner-identified portions of Hinks merely recite "The bar code configuration 10 includes even **surface** portions such as flats 16 separated by uneven **surface** portions such as rib portions 17..."

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause (b) of Claim 43.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 43 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 43. Applicant respectfully asks Examiner to hold Claim 43 allowable and to issue a Notice of Allowance of same.

## **2. Claims 44-48 Patentable for at Least Reasons of Dependency from Claim 43**

Claims 44-48 depend either directly or indirectly from Claim 43. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 44-48 are patentable for at least the reasons why Claim 43 is patentable. Accordingly, Applicant respectfully requests that Examiner hold Claims 44-48 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

### **3. Claim 47 Independently Patentable**

Claim 47 recites as follows: "the producing comprises making the three-dimensional configuration directly accessible by physically separating the at least one portion into at least two part." As shown following, the technical material cited by Examiner does not recite the text of Claim 47, and thus Applicant respectfully requests that Examiner allow Claim 47 for at least those reasons.

#### **a) The Examiner has Failed to Provide Support for Examiners Assertion that Hinks recites Claim 47**

With respect to Claim 47, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light..." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully submits that the Examiner has failed to cite any portion of Hinks which the Examiner views as reciting "the producing comprises making the three-dimensional configuration directly accessible by physically separating the at least one portion into at least two part "-related text of Claim 47.

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability...."))).

As the Examiner has failed to specify in the written record the portions of Hinks which the Examiner views as reciting Claim 47, the Examiner has failed to establish a *prima facie* case of unpatentability of Claim 47.

#### **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 47.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 47 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 47. Applicant respectfully asks Examiner to hold Claim 47 allowable and to issue a Notice of Allowance of same.

#### **4. Claim 48 Independently Patentable**

Claim 48 recites as follows: "the producing comprises making the three-dimensional configuration directly accessible only by disassembling the item."

As shown following, the technical material cited by Examiner does not recite the text of Claim 48, and thus Applicant respectfully requests that Examiner allow Claim 48 for at least those reasons.

##### **a) The Examiner has Improperly Mapped the Recitations of Claim 48 to the Recitations of Hinks**

With respect to Claim 48, Examiner has stated "Hinks teaches...an outer part (tire 14) including at least one outer material that is substantially opaque to visible light...wherein the at least one three-dimensional configuration is directly accessible only by disassembling the item (col. 3, lines 56-63)." See *Examiner's Office Action*, p. 2-3 (1 April 2009).

Applicant respectfully disagrees and traverses the rejection. Applicant respectfully points out that Applicant has reviewed the portions of the Hinks identified by Examiner, and, as far as Applicant can discern, the Examiner-identified portions of

Hinks do not recite the text of Applicant's Claim 48. Rather, the portion of Hinks cited by Examiner recites as follows:

In order to mold the bar code configuration 10 in the sidewall 12 of the tire 14, an insert 50 is fastened to an inner mold face 52 of a mold 54 which may be a two-piece mold as shown in FIG. 7. The mold 54 has a mold cavity 56 in which the uncured tire 14 is placed and the mold closed. A curing bladder 58 may be expanded into contact with the inner surface of the tire 14 during the curing process.

*Hinks, col. 3, lines 56-63 (Emphasis added).*

As can be seen from the foregoing, the portions of Hinks cited by the Examiner with respect of Claim 48 (i.e. those portions which, on their face, must establish a *prima facie* case of unpatentability) do not recite the text of Claim 48. Particularly, Hinks fails to recite “the producing comprises making the three-dimensional configuration directly accessible only by disassembling the item.” Rather, the portion of Hinks cited by the Examiner merely recites: “an insert 50 is fastened to an inner mold face 52 of a mold 54 which may be a two-piece mold as shown in FIG. 7.”

## **b) Conclusion**

Given that Applicant has shown, above, what Hinks actually recites, the question thus naturally arises as to how Examiner saw Hinks as teaching clause Claim 48.

Applicant respectfully points out that the Applicant's Application is the only one objective examiner-cited document of record that shows or suggests what Examiner purports the reference to teach. From this and the Hinks' express recitations (see above), it follows that Examiner is interpreting Hinks through the lens of Applicant's application, which is impermissible hindsight use. Thus, at present, Examiner's assertions regarding Hinks are untenable. Applicant further respectfully points out that the Examiner may be relying on personal knowledge in rejecting Claim 48 in view of Hinks. If so, Applicant respectfully requests an affidavit detailing such personal knowledge.

Accordingly, under the MPEP standards as set forth above, the Examiner has not established a *prima facie* case that art of record anticipates Claim 48. Applicant

respectfully asks Examiner to hold Claim 48 allowable and to issue a Notice of Allowance of same.

#### **IV. CONCLUSION**

Applicant may have during the course of prosecution cancelled and/or amended one or more claims. Applicant notes that any such cancellations and/or amendments will have transpired (i) prior to issuance and (ii) in the context of the rules that govern claim interpretation during prosecution before the United States Patent and Trademark Office (USPTO). Applicant notes that the rules that govern claim interpretation during prosecution form a radically different context than the rules that govern claim interpretation subsequent to a patent issuing. Accordingly, Applicant respectfully submits that any cancellations and/or amendments during the course of prosecution should be held to be tangential to and/or unrelated to patentability in the event that such cancellations and/or amendments are viewed in a post-issuance context under post-issuance claim interpretation rules.

Insofar as that the Applicant may have during the course of prosecution cancelled/amended/argued claims sufficient to obtain a Notice of Allowability of all claims pending, Applicant may not have during the course of prosecution explicitly addressed all rejections and/or statements in Examiner's Office Action. The fact that rejections and/or statements during the course of prosecution may not be explicitly addressed should NOT be taken as an admission of any sort, and Applicant hereby reserves any and all rights to contest such rejections and/or statements at a later time. Specifically, no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended (e.g., with respect to any facts of which Examiner took Official Notice, and/or for which Examiner has supplied no objective showing, Applicant hereby contests those facts and requests express documentary proof of such facts at such time at which such facts may become relevant). For example, although not expressly set forth during the course of prosecution, Applicant continues to assert all points of (e.g. caused by, resulting from, responsive to, etc.) any previous Office Action, and no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended. Specifically, insofar as that

Applicant does not consider the cancelled/unamended claims to be unpatentable, Applicant hereby gives notice that it that it may intend to file and/or has filed a continuing application in order prosecute such unamended claims.

With respect to any cancelled claims, such cancelled claims were and continue to be a part of the original and/or present patent application(s). Applicant hereby reserves all rights to present any cancelled claim or claims for examination at a later time in this or another application. Applicant hereby gives public notice that any cancelled claims are still to be considered as present in all related patent application(s) (e.g. the original and/or present patent application) for all appropriate purposes (e.g., written description and/or enablement). Applicant does NOT intend to dedicate the subject matter of any cancelled claims to the public.

The Examiner is encouraged to contact the undersigned by telephone at (402) 496-0300 to discuss the above and any other distinctions between the claims and the applied references, if desired. Also, if the Examiner notes any informalities in the claims, he is encouraged to contact the undersigned to expediently correct such informalities.

Respectfully submitted,

Dated: July 7, 2009

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Enclosures:

Petition – Extension of Time (one-month)